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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,733

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Junichi Koyama

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EXAMINER

HASHEM, LISA

ART UNIT

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2614

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,733	Applicant(s) KOYAMA, JUNICHI	
	Examiner LISA HASHEM	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Amendment, filed 1-29-08, with respect to the rejection(s) of claim(s) 1-20 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejections below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The 'signal' cited in claim 7, line 3 is non-statutory. The claimed signal has no physical structure, does not perform any useful, concrete and tangible result, and thus does not fit with the definition of statutory subject matter. Appropriate action is required.

4. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 recites '...a computer program product comprising a computer readable medium having computer readable program code...'. The term 'product' in this claim is directed to non-statutory subject matter because the specification does not provide metes and bounds for the 'product' in which the 'computer program product' could be 'computer program instructions' which is not tangible and therefore non-statutory. Appropriate action is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Pat. Appl. Publ. 2003/0202648 by Masuhiro et al, hereinafter Masuhiro in view of U.S. Pat. No. 6,847,634 by Peace et al, hereinafter Pearce.

The applied reference (Masuhiro) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

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Regarding claim 1, Masuhiro discloses an Internet protocol (IP) private branch exchange (Fig. 1, 1) comprising:

a software-based built-in control unit (Fig. 1: 2 (multimedia gateway controller), 101 (system bus), 3 (control interface)) (section 0042-0043); at least one card slot (Fig. 1, 102 (expansion system bus); Fig. 3, 41 (system bus interface)) into which a control card is plugged (Fig. 1: 4-3, 4-4 (protocol handler or PH); Fig. 3, 4 (PH)) (section 0054-0055); and a data bus (Fig. 1, 102 (expansion system bus)) connecting said software-based built-in control unit and said card slot (Fig. 3, 41) (section 0054), wherein said software-based built-in control unit includes: a first management unit (Fig. 1: 4-1, 4-2; Fig. 3, 4) managing up to a first number of Internet Protocol terminals (Fig. 1: 7-1, 7-2) (section 0043; 0045; 0073); and an Internet Protocol terminal registering unit (Fig. 1, 2) connected to said first management unit and said card slot (section 0043), wherein said control card (Fig. 1: 4-3, 4-4; Fig. 3, 4) includes a second management unit (Fig. 3, 42) managing up to a second number of Internet Protocol terminals (Fig. 1: 7-1, 7-2) (section 0043; 0045; 0073), wherein said Internet Protocol terminal registering unit when an Internet Protocol terminal requests communication, said Internet Protocol terminal having an ID number and an Internet Protocol address (section 0061), said Internet Protocol terminal registering unit associates said one management unit with said ID number and said Internet Protocol address, and said one management unit manages said Internet Protocol terminal (section 0062-0063; 0083-0086),

wherein said first and second management unit compares a current number of Internet Protocol terminals (Fig. 1: 7-1, 7-2) managed by one of said first management unit and said second

management unit with corresponding one of said first number and said second number (i.e. upper limit to the number of terminals that can be controlled by the PH; section 0055).

Masuhira discloses an Internet Protocol private branch exchange including a software-based built-in control unit and card mode. However, Masuhira does not disclose said Internet Protocol registering unit comparing current number of Internet Protocol terminals managed by one of said first management unit and said second management unit with corresponding one of said first number and said second number.

Pearce discloses an Internet Protocol terminal registering unit (Fig. 4, 102a (call control module); col. 5, lines 12-21 and lines 39-50) connected to a first management unit (Fig. 4, 26a (call manager));

a first management unit managing up to a first number of Internet Protocol (Internet Protocol) terminals (Fig. 2, 22) (col. 4, lines 21-23);

a second management unit (Fig. 4, 26b (call manager)) managing up to a second number of Internet Protocol terminals (Fig. 2, 22) (col. 4, lines 21-23),

wherein said Internet Protocol terminal registering unit compares a current number of Internet Protocol terminals managed by one of said first management unit and said second management unit with corresponding one of said first number and said second number (i.e. excess load) when an Internet Protocol terminal (i.e. new telephony device) requests communication (col. 4, line 64 – col. 5, line 3), said Internet Protocol terminal having an identification number and an Internet Protocol address (col. 4, lines 33-51), wherein, if said current number is smaller than said one number, said Internet Protocol terminal registering unit associates said one management unit with said identification number and said Internet Protocol address, and said one management unit

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manages (i.e. particular call manager) said Internet Protocol terminal (col. 5, lines 39-50), wherein, if said current number is equal to said one number, said Internet Protocol terminal registering unit associates another of said first management unit and said second management unit (i.e. alternative call manager) with said identification number and said Internet Protocol address, and said another management unit manages said Internet Protocol terminal (i.e. this occurs to provide load balancing between the call managers; col. 4, line 52 – col. 5, line 3; col. 8, lines 58-62).

Again, Masuhiro discloses the claimed private branch exchange except Masuhiro discloses the exchange is able to accommodate a plurality of terminals by increasing the number of protocol handlers in the exchange. However, the claimed feature of selecting which management unit manages an IP terminal was old and well known in the art. Pearce clearly teaches such concept.

Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the private branch exchange of Masuhiro to include comparing a current number of Internet Protocol terminals managed by one of said first management unit and said second management unit with corresponding one of said first number and said second number as taught by Pearce. One of ordinary skill in the art would have been lead to make such a modification of Masuhiro to include selecting a management unit to manage an IP terminal, such as the call manager of Pearce, to the IP terminal registering unit of Masuhiro so IP terminal registering unit of Masuhiro can assign an IP terminal to a management unit based on the number of IP terminals that the management unit can support and provide a backup capability to select

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another management unit if the initial management unit has an excess load of IP terminals assigned to it.

Regarding claim 2, see Masuhiro: section 0052; 0062; 0070.

Regarding claim 3, see Masuhiro: section 0069-0070.

Regarding claim 4, please see the rejection to claim 1 above, wherein Masuhiro discloses an Internet protocol private branch exchange system (Fig. 1) comprising: an Internet protocol branch exchange (Fig. 1, 1); a plurality of Internet protocol terminals (Fig. 1: 7-1, 702;); and a network connecting said Internet protocol branch exchange and said plurality of Internet protocol terminals (section 0043; 0045; 0073); and wherein one of said plurality of Internet protocol terminals requests communication (section 0061-0062).

Regarding claims 5-7, please see the rejections to claims 2, 3, and 3, respectively, to reject the system in claims 5-7.

Regarding claim 8, please see the rejection to claim 1, wherein Masuhiro discloses computer program product comprising: a computer readable medium (Fig. 2, 21; i.e. main processor) having computer readable program code embodied therein configured for controlling an Internet Protocol private branch exchange (section 0047).

Regarding claim 9, see Masuhiro: Fig. 2: 23 (base data memory), 231 (flexible data memory); section 0047.

Regarding claim 10, see Masuhiro: Fig. 2: 22 (first interface unit); section 0043, 0047.

Regarding claim 11, see Masuhiro: Fig. 2, 22; section 0047.

Regarding claim 12, see Masuhiro: Fig. 2: 2, 22; section 0047.

Regarding claim 13, see Masuhiro: Fig. 1, 102; section 0054.

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Regarding claim 14, see Masuhiro: Fig. 3, 49 (second interface unit); section 0048, 0057.

Regarding claim 15, see Masuhiro: Fig. 3, 49; section 0048, 0057.

Regarding claim 16, see Masuhiro: section 0047, 0052, 0061, 0082, 0085.

Regarding claim 17, see Masuhiro: section 0047, 0052, 0061, 0082, 0085.

Regarding claim 18, see Masuhiro: section 0047, 0052, 0061, 0082, 0085.

Regarding claim 19, see Masuhiro: section 0047, 0052, 0061, 0082, 0085.

Regarding claim 20, see Masuhiro: section 0047, 0052, 0061, 0082, 0085.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-7, 10, and 14-16 of copending Application No. 10/419,766 by Masuhiro (hereinafter '766 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

It would be obvious to one of ordinary skilled in the art to utilize the exchange in claims 1 and 5-7 and the method in claims 10 and 14-16 in the '766 application to disclose an Internet Protocol private branch exchange that '...compares a current number of Internet Protocol terminals managed by one of said first management unit and said second management unit with corresponding one of said first number and said second number when an Internet Protocol terminal requests communication, said Internet Protocol terminal having an identification number and an Internet Protocol address, wherein, if said current number is smaller than said one number, said Internet Protocol terminal registering unit associates said one management unit with said identification number and said Internet Protocol address, and said one management unit manages said Internet Protocol terminal, wherein, if said current number is equal to said one number, said Internet Protocol terminal registering unit associates another of said first management unit and said second management unit with said identification number and said Internet Protocol address, and said another management unit manages said Internet Protocol terminal...', as in claims 1, 4, and 8 in the instant application.

For these reasons, independent claims 1, 4, and 8 are rejected. Claims 2, 3, 5-7, and 9-20 are dependent of claims 1, 4, and 8 and are rejected on the ground of nonstatutory obviousness-type double patenting under the same reasons set forth in claims 1, 4, and 8.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

10. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISA HASHEM whose telephone number is (571)272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Tsang/
Supervisory Patent Examiner, Art Unit 2614

/Lisa Hashem/
Examiner, Art Unit 2614
April 30, 2008